

Serial No. 10/797,120
Amdt. dated December 29, 2004
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REMARKS

The Examiner has rejected claim 1 as being unpatentable over Zumberge in view of McGuiness or Shanley. Applicant respectfully disagrees. There is no teaching or suggestion in Zumberge that it would be desirable to use static cling instead of adhesive to attach the labels to the inner surface of the card. There is no disclosure that static cling labels would be suitable for the intended purpose of the adhesive-back labels, such as placing them in a personal planner, in a file relating to the person identified on the business card or on a conventional ROLODEX®-style card organizer. See column 4, lines 44-48.

The Examiner has also rejected claim 1 as being unpatentable over McGuiness or Shanley. Applicant respectfully disagrees. Claim 1 requires that the static cling sheet have the same information as the information on the second side of the sheet. The Board of Patent Appeals and Interferences has said in the parent application No. 09/629,450, "[T]he limitation that the same information be placed on the second side of the sheet and on the static cling sheet cannot simply be ignored in assessing the patentability of claim 1. Neither McGuiness nor Shanley expressly discloses any common information on the static cling sheet and the opposite side of the sheet to which the static cling sheet is attached and the Examiner has not offered any explanation as to why it would have been obvious to do so. The mere fact that the prior

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art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

The Examiner has also rejected claim 6 as being unpatentable over McGuiness or Shanley. Applicant respectfully disagrees. Claim 6 is entitled to the priority of application Serial No. 08/968,667, filed November 12, 1997, now U.S. Patent No. 5,914,158. The disclosure in the '158 patent clearly supports claim 6. See column 4, line 10. Accordingly, McGuiness cannot be used as a reference.

Further, Shanley does not appear to disclose indicia on the opposite side of the service invoice record form. The Examiner's statement that "most auto service forms have indicia on both sides and are well known in the art" is not supported by evidence in the record.

In view of the above, it is asserted that claims 1-12 are patentable over the cited references and are asserted to be in condition for allowance. Reconsideration of rejection is respectfully requested and an early and favorable action is earnestly solicited.


Applicant hereby requests an extension of time for three (3) month through December 29, 2004, in order to timely file this amendment. A check in the amount of \$510.00 is attached herewith for the extension fee.

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Please charge Deposit Account No. 19-2105 for any additional fees required to be paid in connection with this submission.

Respectfully submitted,



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